

REMARKS

This is a full and timely response to the outstanding final Office Action mailed January 23, 2007. Through this response, claims 9 and 17 have been amended to replace "present" with "available," hence placing claims 9 and 17 in better condition for appeal or allowance. Applicants respectfully submit that, through these claim amendments, there are no new issues being introduced nor is a new search necessitated by these amendments. Reconsideration and allowance of the application and pending claims 9, 13-17, and 20-23 are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection

Claims 1, 2, 5, 7-9, 13, 15-17, 20, 22, and 23 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Chen et al.* ("*Chen*," U.S. Pat. No. 6,552,744) in view of *Burt et al.* ("*Burt*," U.S. Pat. No. 5,999,662) and *Ishihama et al.* ("*Ishihama*," U.S. Pat. No. 5,557,328). Claims 6, 13, and 21 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Chen et al.* ("*Chen*," U.S. Pat. No. 6,552,744) in view of *Burt et al.* ("*Burt*," U.S. Pat. No. 5,999,662) and *Ishihama et al.* ("*Ishihama*," U.S. Pat. No. 5,557,328) as applied to claims 1, 9, and 17 above and further, in view of *Weldy et al.* ("*Weldy*," European Pat. No. 0858208). Applicants respectfully traverse these rejections.

B. Discussion of the Rejection

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

Independent Claim 9

Claim 9 recites (with emphasis added):

9. A method of controlling the operation of a digital camera, comprising:
 - storing, in memory of the digital camera, at least two captured images representing different image views of a scene;
 - merging, in the digital camera, the at least two captured images to form a merged image;
 - displaying the merged image on a display of the digital camera;
 - deleting a cropped portion of the merged image such that information corresponding to cropped portions of the captured images are no longer available in the digital camera;
 - storing, in memory of the digital camera, an uncropped portion of the merged image***, the cropped portion of the merged image not being stored in the memory.

Applicants respectfully submit that *Chen* in view of *Burt* and *Ishihama* fails to disclose, teach, or suggest at least the above-emphasized claim features. As correctly noted in the Office Action on page 3, *Chen* fails to disclose “***storing, in memory of the digital camera, an uncropped portion of the merged image.***” Additionally, *Burt* does not disclose, teach, or suggest storing the “uncropped portion of the merged image” in the “***digital camera.***” Further, assuming *arguendo* that the magnification process described in *Ishihama* can be construed as equivalent to a cropping operation, the admission of which is neither expressed nor implied, there is no teaching or disclosure of storing an ***uncropped portion of the merged image*** (defined in claim 9 as comprising at least two captured images) in

the digital camera. Thus, Applicants respectfully submit that claim 1 is allowable over in view of *Burt* and *Ishihama*.

Additionally, Applicants respectfully submit that the addition of *Burt* to *Ishihama* and *Chen* is not obvious. For instance, *Ishihama* and *Chen* focus on operations at the digital camera, whereas *Burt* teaches post-camera operations. Such an attempt at combining *Burt* with the *Ishihama* and *Chen* references appears more likely to result from hindsight reasoning, or more generally, fails to satisfy the "as a whole inquiry" established under obviousness case law. That is, according to established case law, "Title 35, section 103, requires assessment of the invention as a whole. This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Princeton Biochemicals Inc. v. Beckman Coulter Inc.*, 75 U.S.P.Q.2d. 1051, 1054 (Fed. Cir. 2005). This showing has simply not been set forth. As explained in *Princeton Biochemicals Inc. v. Beckman Coulter Inc.*, 75 U.S.P.Q.2d. 1051, 1054 (Fed. Cir. 2005), "the 'as a whole' instruction in title 35 prevents evaluation of the invention part by part." (citing *Ruiz v A.B. Chance Co.*, 357 F.3d 1275 (Fed. Cir. 2004)) As further stated in *Princeton*, "[W]ithout this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component." (*Id.*, as to *Ruiz*). The court in *Princeton* explained that "[T]his line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. (*Id.*, as to *Ruiz*)

Applied to the case at hand, it is clear that one problem with conventional systems is that of combining two images and cropping the same in the camera. (see,

e.g., Background of Applicants' disclosure, page 2, lines 5-11) *Burt* appears to focus *arguendo* on combining and cropping, not at the camera, but instead at a computer system (image processing system) beyond the camera. Hence, *Burt* represents one of the problems that certain embodiments of Applicants' disclosure, as provided in claim 9, attempts to resolve. Hence, it is not obvious to combine the post-camera system of *Burt* with camera centric references *Ishihama* and *Chen*. Thus, for these additional and separate reasons, Applicants respectfully request that the rejection to claim 9 be withdrawn.

Because independent claim 9 is allowable over *Chen* in view of *Burt* and *Ishihama*, dependent claims 13 and 15 are allowable as a matter of law for at least the reason that the dependent claims 13 and 15 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 17

Claim 17 recites (with emphasis added):

17. A computer readable medium for controlling the operation of a digital camera, comprising:
 - logic that merges at least two captured images, which have been stored in memory, corresponding to two different image views of a scene to form a merged image in the digital camera;
 - logic that stores an uncropped portion of the merged image in memory of the digital camera;** and
 - logic that deletes a cropped portion of the merged image prior to storing the uncropped portion of the merged image such that information corresponding to cropped portions of the captured images are no longer available in the digital camera.

For similar reasons presented above in association with claim 9, Applicants respectfully submit that *Chen* in view of *Burt* and *Ishihama* fails to disclose, teach, or suggest at least the above-emphasized claim features. Accordingly, Applicants respectfully submit that claim 17 is allowable over the art of record and respectfully request that the rejection to claim 17 be withdrawn.

Additionally, as explained above in association with independent claim 9, Applicants respectfully submit that the addition of *Burt* to *Ishihama* and *Chen* is not obvious. Accordingly, Applicants respectfully request that the rejection to claim 17 be withdrawn for this additional and separate reason.

Because independent claim 17 is allowable over *Chen* in view of *Burt* and *Ishihama*, dependent claims 20, 22, and 23 are allowable as a matter of law

Dependent Claims 6, 13, and 21

As explained above, Applicants respectfully submit that *Chen* in view of *Burt* and *Ishihama* fails to disclose, teach, or suggest at least the above-emphasized features of claims 9 and 17. *Weldy* fails to remedy these deficiencies. Thus, claims 9 and 17 are allowable over *Chen* in view of *Burt* and *Ishihama* and *Weldy*. Additionally, because claims 6, 13, and 21 depend from their respective allowable base claims 9 and 17, Applicants respectfully submit that claims 6, 13, and 21 are allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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